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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/759,196	01/20/2004	Shigeru Shoji	247685US2	7750
22850	7590	09/07/2005	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			PHAN, THIEM D	
			ART UNIT	PAPER NUMBER
			3729	
DATE MAILED: 09/07/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/759,196	Applicant(s) SHOJI, SHIGERU	
	Examiner Tim Phan	Art Unit 3729	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 08 July 2005.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) 1-5 and 11-13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 6-8 is/are rejected.
- 7) ☒ Claim(s) 9 and 10 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. <u>7/12/05</u> . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)                                   |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>7/8/05 &amp; 1/20/04</u> . | 6) <input checked="" type="checkbox"/> Other: <u>See Continuation Sheet</u> .                                 |

**Continuation of Attachment(s) 6).**

**Supplemental Office Action Summary (PTOL-326) to correct error due to a blank form (PTOL-326) being sent out on 6/8/05 for Restriction Requirement.**

## DETAILED ACTION

### *Election/Restrictions*

1. Applicants' election with traverse of Group I-B (claims 6-10 filed on 6/08/05) is acknowledged. The traversal is on the ground(s) that the Group I-B claims, drawn to a method of producing a helical coil chip, is part of an overlapping search area of other groups, therefore no burden is placed on the examiner. This is not found persuasive because the examiner has established a prima facie case having shown in the Action filed on 6/08/05, that the invention of Group I-B has a separate classification (class 29, subclass 872) from the inventions of Group I-A (class 29, subclass 602.1) or Group II (class 336, subclass 200) or Group III (class 257, subclass 531). Moreover, the inventions of Groups I-A, I-B, II and III each have a separate status in the art and clearly have a separate field of search which would be non-coextensive.

In accordance with MPEP § 803, the examiner has demonstrated that the inventions of Groups I-A, I-B, II and II are each independent or distinct as claimed (filed on 6/08/05)) and a serious burden would be placed on the examiner as discussed above.

Accordingly, Claims 1-5 and 11-13 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected Groups, there being no allowable generic or linking claim.

The Restriction filed on 6/08/05 is hereby **made Final**.

Applicants are required to cancel these nonelected claims (1-5 & 11-13) or take other appropriate action.

An Office Action on the merits of Claims 6-10 now follows.

### *Specification*

2.

- On page 1, before “BACKGROUND OF THE INVENTION”, insert:

#### “CROSS REFERENCE TO RELATED DOCUMENT

This application claims priority to Japanese Patent Applications No. 2003-012046, filed on January 21, 2003.”.

- The following title is suggested: “A Method of Producing a Helical Coil Chip”.

### *Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claim 6 is rejected under 35 U.S.C. 102(b) as being anticipated by Kano et al (JP 59-103321).

**As applied to claim 6, Kano et al teach a process of manufacturing coil, comprising:**

- **forming a plurality of wires (Fig. 5, 16; Abstract, line 18) extending parallel to each other with predetermined intervals on an upper surface and a lower surface of a substrate (Fig. 3, 10), wherein said wires on the upper and lower surfaces of said substrate are arranged to extend in the same direction;**
- **cutting said substrate in a direction different from the direction in which said wires extend, like along the slit (Fig. 5, 11; Abstract, line 18) in such a way that said wires are cut to a predetermined length, into a plurality of cut substrates;**
- **reconstructing said cut substrates as a collective substrate (Fig. 6, 101-104), wherein the cut surfaces (Fig. 6, 17) of said cut substrates are arranged to face upward and downward in said collective substrate; and**
- **forming a plurality of wires (Fig. 7, 18), which have a length equal to the thickness of said substrate (Fig. 3, 10; partial translation/explanation of JP 59-103321 by US 6,686,824, col. 1, lines 20-40) plus the thickness of said wires formed on the upper and lower surfaces of said substrate and extend parallel to each other with said predetermined intervals, on the upper and lower surfaces of said collective substrate, wherein each of said plurality of wires connects end portions of said wires formed on the upper and lower surfaces of said substrate that pass through the thickness of said collective substrate.**

The limitations of the claim "...by means of an adhesive and a plurality of supplemental members," are considered to be of an apparatus wherein the process of producing a helical coil chip operates so this manner of operation does not distinguish over the process of Kano et al, and Kano et al at a minimum suggest the claimed method invention.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 7, and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kano et al in view of Amada et al (US 6,449,830) or vice versa.

**As applied to claim 7,** Kano et al teach a process of manufacturing coil, which reads on applicants' claimed invention.

Amada et al teaches a method of manufacturing wire wound electronic component with a resin coating (Fig. 4A, 6) to protect the inductive coil (Fig. 4A, 4).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the two teachings by applying the resin coating, as taught by Amada et al and not its general structure, in order to protect the inductive coil.

As applied to claim 8, Kano et al teach a process of manufacturing coil, which reads on applicants' claimed invention.

Amada et al teaches a method of manufacturing wire wound electronic component with a terminal electrode or cap (Fig. 4A, 7) to provide inductance from the component to the connected circuit

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the two teachings by applying the terminal electrode or cap, as taught by Amada et al and not its general structure, in order to provide inductance from the component to the connected circuit.

#### *Allowable Subject Matter*

7. Claims 9 and 10 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### *Conclusion*

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the



examiner should be directed to Tim Phan whose telephone number is 571-272-4568. The examiner can normally be reached on M - F, 9AM - 5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on 571-272-4690. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Tim Phan  
Examiner  
Art Unit 3729

tp  
August 12, 2005



**A. DEXTER TUGBANG**  
**PRIMARY EXAMINER**